

**REMARKS****Telephonic interview of January 12, 2006**

Applicants thank the Examiner for the very courteous and helpful telephonic interview of January 12, 2006. In the interview, the outstanding rejections and proposed claim amendments addressing these issues for placing this application in condition for allowance were discussed. Applicants have endeavored to address all the outstanding issues set forth in the non-final office action of August 09, 2005, and as discussed in the telephonic interview, in the instant amendment.

**Status of the Claims***Pending claims*

Claims 1, 2, 5, 6, 11, 12, 15, 16, 29, 47 to 75, 87, 88, 95 to 107, 111 to 115, and 117 to 122 and 125 to 132 are pending. Claims 49 to 73, 95 to 100, 107, 111 to 115 and 117 to 122 are withdrawn from consideration. Accordingly, claims 1, 2, 5, 6, 11, 12, 15, 16, 29, 47, 48, 74, 75, 87, 88, 101 to 106, and 125 to 132 are pending and under consideration.

*Claims canceled in this response*

Claims 5, 11, 15, 63 to 67, 125 to 129, are canceled, without prejudice. Thus, after entry of the instant amendment, claims 1, 2, 6, 12, 16, 29, 47, 48, 74, 75, 87, 88, 101 to 106, and 130 to 132, will be pending and under consideration.

*Outstanding Rejections*

Claims 102, 105 and 106 are rejected under 35 U.S.C. §101. Claims 1, 2, 5, 6, 11, 12, 15, 16, 29, 47, 48, 74, 75, 87, 88, 101 to 106 and 125 to 132, stand rejected under 35 U.S.C. §112, second paragraph. Claims 29, 74 to 88 and 125 to 132 stand rejected under 35 U.S.C. §112, first paragraph, written description requirement. Claims 1, 2, 5, 6, 11, 12, 15, 16, 29, 47, 48, 74 to 75, 87, 88, 101 to 106 and 125 to 132, stand rejected under 35 U.S.C. §112, first paragraph, enablement requirement. Applicants respectfully traverse all outstanding objections to the specification and rejection of the claims.

Support for the Claim Amendments

The specification sets forth an extensive description of the invention as set forth in the pending, new and amended claims. For example, support for claims directed to wash step conditions can be found, inter alia, in paragraph [0165], page 48, of the specification as filed (which is paragraph [0183] of this application's publication U.S. Pat. App. No. 20030170634). Support for very highly stringent hybridization conditions can be found in paragraph [0172], pages 49, 50 of the application as filed (which is paragraph [0190] of this application's publication U.S. Pat. App. No. 20030170634). Support for claims directed to nucleic acids encoding polypeptides capable of hydrolyzing a starch to a sugar can be found in paragraph [0043], page 9.

The Restriction Requirement, Election and Traversal

The Patent Office alleged that the pending claims of the application are directed to nineteen (XIX) separate and distinct inventions under 35 U.S.C. §121. In response, Applicants elected Group I, claims 1 to 29, 47, 48, 74 to 92 and 101 to 106, drawn to polynucleotides, vectors, host cells comprising same, probes for same and a method of making a polypeptide using the polynucleotides of the invention, with traverse, giving reasons to reconsider and withdraw the restriction requirement.

*Rejoining claims under In re Ochiai*

Applicants respectfully request that after the elected product claims have been found to be allowable all withdrawn process (methods) claims which depend from or otherwise include all of the limitations of the allowed product claims be rejoined. MPEP §821.04; pg 800-63 to 800-70, 8th Ed., Rev. 3, Aug. 2005; In re Ochiai, 37 USPQ2d 1127 (Fed. Cir. 1995); In re Brouwer, 37 USPQ2d 1663 (Fed. Cir. 1995); 1184 OG 86, 3/26/96.

Applicants respectfully request that after the elected product claims have been found to be allowable, the withdrawn process (methods) claims of Groups IV, VII, VIII, IX, XI, XIII, XIV, XV, XVI, XVIII and XIX should be rejoined.

Supplemental Information Disclosure Statements

Applicants thank the Examiner for considering and initialing the non-patent literature listed on the Supplemental Information Disclosure Statements (IDSs) submitted on September 09, 2005, April 11, 2005, and March 10, 2005. It is respectfully requested that the cited information be expressly considered during the prosecution of this application, and the references be made of record therein and appear among the "references cited" on any patent to issue therefrom.

Issues under 35 U.S.C. §101

Claims 102, 105 and 106 are rejected under 35 U.S.C. §101, as allegedly drawn to non-statutory subject matter, for reasons set forth on page 2, of the OA. The instant amendment addresses these issues.

Issues under 35 U.S.C. §112, second paragraph

Claims 1, 2, 5, 6, 11, 12, 15, 16, 29, 47, 48, 74, 75, 87, 88, 101 to 106 and 125 to 132, stand rejected under 35 U.S.C. §112, second paragraph, for reasons set forth on pages 3 to 4 of the OA. The instant amendment addresses these issues.

Issues under 35 U.S.C. §112, first paragraphWritten Description

Claims 74 to 88 stand rejected under 35 U.S.C. §112, first paragraph, written description requirement, for reasons set forth on page 5, of the OA; and claims 29 and 125 to 132, stand rejected under 35 U.S.C. §112, first paragraph, written description requirement, for reasons set forth on pages 12 to 15, of the OA. The instant amendment addresses these issues.

While Applicants traverse the rejection, to expedite prosecution of this application by this amendment they have endeavored to address all the outstanding section 112, first paragraph, written description issues set forth in the non-final office action of August 09, 2005, and as discussed in the telephonic interview to place the claims in condition for allowance.

Enablement

Claims 1, 2, 5, 6, 11, 12, 15, 16, 29, 47, 48, 74 to 75, 87, 88, 101 to 106 and 125 to 132 stand rejected under 35 U.S.C. §112, first paragraph, enablement requirement, as allegedly not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention, for reasons set forth on pages 5 to 12, of the OA. The instant amendment addresses these issues.

While Applicants traverse the rejection, to expedite prosecution of this application by this amendment they have endeavored to address all the outstanding section 112, first paragraph, enablement issues set forth in the non-final office action of August 09, 2005, and as discussed in the telephonic interview to place the claims in condition for allowance.

CONCLUSION

Applicants respectfully submit that after entry of the instant amendment all claims pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Applicants believe that no fees are necessitated by the present response and amendment. However, in the event any such fees are due, the Commissioner is hereby authorized to charge any such fees to Deposit Account No. 03-1952 referencing attorney docket no. 564462006000. Please credit any overpayment to this account.

If another telephonic conference would expedite prosecution of this application, please telephone the undersigned at 858 720 5133.

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Respectfully submitted,

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